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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,061	01/30/2001	Neal A. Osborn	PALM-3285.US.P	6019

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EXAMINER

PAN, YUWEN

ART UNIT PAPER NUMBER

2682

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/773,061

Applicant(s)

OSBORN ET AL.

Examiner

Yuwen Pan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

1. Applicant's arguments filed 1/26/04 have been fully considered but they are not persuasive.

The applicant argues that Hild reference doesn't teach the claim limitation of "in response to step b), said electronic device automatically displaying a message indicating a user selection" and "responsive to said user selection, ... said second electronic device automatically as recited by claims 1, 8 and 14. The examiner respectfully disagrees because regardless of the recited column 16 and lines 4-14, with today, the booming of wireless technology, more and more American people have at least one wireless device. The basic function of most wireless devices is able the wireless device to receive messages such as email or voice message. One way to interpret the limitation is that the user has varied option of selection how to receive a message. By default, a message notification, such as mail icon or the body of the message would be displayed on the screen of wireless device automatically. Back to the recited passages, receiving email on the wireless device is one scheme in accordance with Hild's invention. Hild also suggests other schemes such as two electronic devices exchange business card information in the form of user data accordance with Hild's invention.

The applicant further argues that Hild reference doesn't teaches the claim limitation of "responsive to said user selection, ... said second electronic device automatically" as recited by claims 1, 8 and 14. The examiner respectfully disagrees since Hild teaches one embodiment that has a local network with two devices (see figure 2 A-F). The two devices could be the only devices in the local network (see column 12 and line 46-column 13 and line 32). Although this embodiment exchanges remote service lists instead of the business card information, it is also

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applicable to the scheme of passing simple data between electronic devices carried by two human beings, such as an electronic business card (see column 15 and .

In response to the applicant's argument about the different between broadcasting information and the directed communication, the examiner believes that the applicant narrows the meaning of the word "broadcasting". Hild's invention can be used in locals with point-to-point and/or point-to-multipoint connections (see column 8 and lines 9-20). Thus, the term "broadcasting" address the meaning of the directed communication.

The applicant further argues that Hild reference, especially figure 1, doesn't teach the limitation of "a memory coupled to said bus". The examiner respectfully disagrees because figure 1 is just a simple demonstration of a wireless computerized device. One ordinary skill in the art knows that the major components, CPU, memory, hard drive, and etc. of the computer are interconnected via parallel circuits, the bus.

In response to the applicant's argument about the LCD technology, the examiner admit that many electronic device do not comprise an display screen or did comprise an display screen that utilize a different displaying technology, however utilizing LCD technology with portable device is so common and well-known in the real life and on the market. It is not necessary to provide an additional art because the electronic device having LCD has no patentable weight. Same response would apply to the argument about calendar information.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12, 14-18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hild et al (US006532368B1).

With respect to claims 1, 8, 14, Hild discloses a method of communicating information comprising the steps of:

Communicating a first electronic business card from a first electronic device to a second electronic device using a wireless communication mechanism (see column 12 and lines 3-10, column 15 and lines 50-57);

Said second electronic device receiving said first electronic business card (see figure 2D, column 12 and lines 46-61);

In response to previous step, said second electronic device automatically displaying a message indicating a user selection (see column 16 and lines 4-13);

Responsive to said user selection, said second electronic device storing said first electronic business card and automatically communicating a second electronic business card to said first electronic device (see column 13 and lines 12-33).

One portable electronic device (see figure 1) comprising:

A processor coupled to a bus (see figure 1 and item 17);

A transmitter and a receiver (see figure 1 and items 21, 22);

A display screen (see column 16 and line 4-13);

A memory (see figure 1 and item 16).

With respect to claims 2,3 and 9,10, Hild further discloses said wireless communication mechanism is infrared communication and substantially compatible with a Bluetooth communication protocol (see column 3 and lines 5-16).

With respect to claims 4,11, 17, Hild further discloses first and second electronic devices are both palm-sized computer (see column 15 and lines 34-49).

With respect to claim 5, Hild further discloses an electronic business card (see column 15 and lines 50-58).

With respect to claim 6, Hild doesn't disclose calendar information. It is common practice to have contains calendar information for a portable device such as PDA.

With respect to claim 7, Hild further discloses data base files (see figure 2, local service list).

With respect to claims 12 and 18, Hild further discloses that said first electronic business card represents an owner of said first electronic device and wherein said second electronic business card represents an owner of said second electronic device (see figure 2 and column 15 and lines 50-58).

With respect to claim 20, it is common practice that said display screen is a liquid crystal display screen since most of the electronic devices have LCDs.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hild et al (US006532368B1).

With respect to claim 13 and 19, Hild discloses a portable electronic device that allows a user to select between accepting said first electronic business card and accepting said first electronic business card and automatically transmitting said second electronic business card (see column 12 and lines 3-10, column 15 and lines 50-57).

Hild doesn't disclose rejecting said first electronic business card. The examiner takes "Official Notice" that is notoriously well known in the art to have a rejecting mode, in order to discard or block any unnecessary information if the user is no willing to receive. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have this additional rejecting mode such that the user can block or discard any unwanted information.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

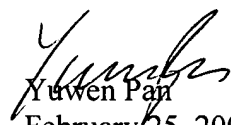
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuwen Pan whose telephone number is 703-305-7372. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yuwen Pan  
February 25, 2004

  
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